

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : FALLS *et al.*
SERIAL NUMBER : 08/983,394 EXAMINER : *To be assigned*
FILING DATE : January 20, 1998 ART UNIT : *Unknown*
FOR : ELECTRONIC PRODUCT INFORMATION DISPLAY SYSTEM

Box DAC
Assistant Commissioner for Patents
Washington, DC 20231

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DECLARATION OF ERNEST J. DALE

1. I, Ernest J. Dale, am over twenty-one years of age, am of sound mind, and am competent to testify to the facts stated in this Declaration. Except as otherwise indicated herein, I have personal knowledge of the facts stated in this Declaration.

Prosecution History

2. The above-referenced patent application S.N. 08/983,934 (the '934 Application) was filed on January 20, 1998, claiming priority to International Application No. PCT/US96/12575 filed July 31, 1996 (the "PCT Application"), filed in the name of Intelledge Corporation, which claimed priority to U.S. Provisional Application No. 60/001,673 filed July 31, 1995 (the "Provisional Application").

3. On August 25, 1998, a Notice of Missing Requirements was mailed to John England at the law firm of Laff, Whitesel and Saret. On September 25, 1998, a response to the Notice of Missing Requirements was filed by Laff, Whitesel and Saret attorney G. Peter Albert, Jr. (Reg. No. 37,268). Although I did not know about it at the time, on January 5, 1999, a Notification of a Defective Oath or Declaration was mailed to Mr. England at Laff, Whitesel and



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Saret, alleging that that the name and signature of one of the inventors (Mr. M.C. Phillips) was missing.

3. Although I did not know it at the time, a Notice of Abandonment in the above-referenced patent application was mailed on January 14, 2000, because Applicants allegedly failed to properly respond to the Notification of a Defective Oath or Declaration. In particular, the applicants allegedly failed to provide an oath or declaration acceptable under 35 U.S.C. §371(c)(4) for entry into the national stage in the United States of America.

The Intelledge Bankruptcy

4. Prior to the abandonment of the '934 application, Intelledge filed for bankruptcy. Pursuant to an Order of Sale, the intellectual property and other assets of Intelledge, including the '934 application, were sold at auction by the bankruptcy trustee.

5. On July 1, 1999, prior to the mailing of the Notice of Abandonment, Information Planning and Management Service, Inc. ("IPMS") purchased the assets of Intelledge, including the '934 Application

6. I am an inventor of the invention embodied in the '934 Application, and I am a principal of IPMS.

7. I caused IPMS to purchase the '934 Application because I believed that a patent to that invention would be valuable.

8. I never intended for the '934 Application to become abandoned and took all reasonable steps to try to prosecute and maintain the application.

9. For a variety of reasons detailed below, from July 1, 1999 to the present, IPMS and I experienced numerous difficulties in obtaining case files, status reports, and other

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information relevant to the intellectual property ("IP") purchased on July 1, 1999. With particular regard to the above-referenced patent application, IPMS and I recently learned of the Notice of Abandonment only after obtaining a copy of the prosecution history of U.S. Application Serial No. 08/983,394 on June 20, 2002.

The Attorneys of Record and Mr. Dale's Initial Attempts to Obtain Information From Them

10. The PCT Application listed Robert S. Beiser of Michael, Best and Friedrich as the Agent. On January 20, 1998, a Revocation and Submission of Power of Attorney was filed in the PCT Application. This Power of Attorney was granted to Mr. England at the law firm of Laff, Whitesel and Saret. An Information Disclosure Statement was filed in the '934 Application by Mr. England on March 17, 1998. Mr. England originally worked for the law firm of Michael, Best and Friedrich. As I later discovered, Mr. England then left Michael Best and worked for the law firm of Sitrick and Sitrick in Lisle, IL. Mr. England subsequently left Sitrick and Sitrick and joined the firm of Laff, Whitesel and Saret in Chicago. He then left Laff, Whitesel to work for Snap-on-Tools.

11. The '934 Application file history reflects that on May 26, 1998, a Revocation and Substitute Power of Attorney was filed granting power of attorney to various attorneys at Laff, Whitesel and Saret and specified Mr. Charles Laff (Reg. No. 19,787) as the attorney to whom to address correspondence should be sent.

12. Subsequently, the Laff, Whitesel and Saret firm apparently merged with the law firm of Michael, Best and Friedrich.

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My Diligent Efforts To Ascertain The Status of the '934 Application.

13. On many occasions beginning around July 1999 through the fall of 1999, I attempted to contact Mr. England at Laff, Whitesel and Saret, which was Mr. England's last known place of employment at that time. I left messages that were never returned. Eventually, I was told that Mr. England no longer worked at the Laff, Whitesel and Saret law firm. I informed Laff, Whitesel and Saret that IPMS had acquired the intellectual property of Intelledge and that I was trying to obtain a status report on the Intelledge patent applications. I was told that Laff, Whitesel and Saret knew nothing about Intelledge files because Mr. England had left Laff, Whitesel and Saret and had taken the Intelledge files with him. Laff, Whitesel informed me that I needed to find Mr. England.

14. I also contacted Mr. Grochosinski, Federal Trustee for the Intelledge bankruptcy settlement in August 1999 and arranged to obtain the stored Intelledge corporate files in Mr. Grochosinski's possession. I made many attempts to get the files. I learned that these files were taken at some point to an incorrect address and were apparently lost. IPMS and I made many attempts to determine what happened to these files, but to date we still have not received them.

15. In September 1999, I contacted the attorney who filed the bankruptcy for Intelledge and determined that the former chief financial officer ("CFO") of Intelledge had certain legal files which might contain status information on the patent applications. I contacted former Intelledge CFO John Schawarko in the first quarter of 2000. Mr. Schawarko indicated he thought Mr. John Noel, former in-house attorney for Intelledge might have the files. I then contacted Mr. Noel. Mr. Noel searched his files and found some relevant files, which he shipped to me. I did receive these files. In the spring of 2000, I located in these files documents relating

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to some of the Intelledge intellectual property matters. Some of these materials listed Mr. Bob Beiser of Michael, Best and Friedrich as a contact person.

16. I then contacted Mr. Beiser. I informed Mr. Beiser that IPMS had acquired the IP assets from Intelledge and was trying to obtain the status of the applications and copies of the files. Mr. Beiser said that Michael Best was not prosecuting the patent application, but that Mr. England was.

17. Mr. Beiser informed me that Mr. England had left Michael Best, had moved on to the law firm of Sitrick and Sitrick in Chicago and had taken the Intelledge files with him.

18. I subsequently contacted the Sitrick firm. At that time, the Chicago office of Sitrick said they did not know where Mr. England was employed, nor did they have an address for him. I again contacted Mr. John Noel, former Intelledge attorney, and Mr. Noel said he believed that Mr. England had gone to Katten Muchin and Zavis, a firm having done other work for Intelledge.

19. I then contacted Katten Muchin and Zavis and explained the situation. In the summer of 2000, Mr. Floyd Mandell of KMZ indicated that they had been unable to find any record of Mr. England working for them and no record of any of their work for Intelledge involving the patent applications. Mr. Mandell suggested that I contact the Patent and Trademark Office, as one of the inventors, to determine the status of the applications.

20. In the summer and fall of 2000, I contacted the PTO several times. The PTO was able to locate two issued Intelledge design patents with me as inventor, but said that they were unable to locate any other patents or applications in my name. If I could get specific application numbers, they said they could help.

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21. In the fall of 2000, I contacted Laff, Whitesel and Saret and, after some effort, was told Laff, Whitesel and Saret knew nothing of the Intelledge patent applications and that Mr. England was the person I should speak to.

22. Through mid-2001, I made several attempts to further pursue the status of the files and Mr. England. I spoke to Mr. Beiser at Michael, Best and Friedrich. Mr. Beiser suggested that Mr. David Sitrick at Sitrick and Sitrick in Lisle, Illinois might have additional information on Mr. England. I contacted David Sitrick and he suggested contacting Mr. Barry Sufrin of Laff, Whitesel and Saret to find Mr. England.

23. After many unsuccessful efforts, I spoke to Mr. Sufrin in early 2002, who again said I needed to talk to Mr. England and that Mr. England was working at Snap-on-Tools in Kenosha, WI. Mr. Sufrin indicated in no uncertain terms that Intelledge owed money to Laff, Whitesel and Saret and that no other help or information would be forthcoming unless I paid the debt left by the Intelledge bankruptcy (for which I was in no way legally or financially responsible).

24. I then contacted Snap-on-Tools and they indicated that Mr. England did not work there. I tried several times to contact Snap-on-Tools' Human Resources director Keith Whitehead, but I was unable to obtain any additional information about Mr. England's whereabouts.

25. At various times throughout 2001 and early 2002, I instructed and supervised several IPMS employees in trying to locate Mr. England using Martindale-Hubble, local bar associations, the American Bar Association, and Lawyers.com, but their efforts were unsuccessful. I instructed and supervised these IPMS employees in attempting to locate former

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Intelledge employees to see if they might have information that could help. Once again, their efforts were unsuccessful.

26. I also instructed and supervised these IPMS employees in trying to gather information from old Intelledge paper files and from former Intelledge employees on what the filing and application numbers had been and had them try to contact the PTO for information. In April 2002, they located the PCT filing number. Based on a request to the PTO in May, I received a letter from the PTO dated May 30, 2002. This letter indicated that the status of the PCT Application was that national stage was entered in the U.S. via the '934 Application and that the '934 Application was abandoned.

27. James G. Gatto, current patent counsel for IPMS, then obtained a power to inspect the '934 Application file from Mr. Laff (who now is at Michael, Best and Friedrich). Mr. Laff further indicated that he had the '934 Application file, but that it did not include the Notice of Abandonment or the document which was not responded to that caused the application to go abandoned.

Attempts to Obtain Files and Information from Former Intelledge Executives

28. Due to my inability to find Mr. England, I made several attempts to obtain information from former Intelledge executives. In particular, I spoke several times with Mr. Schwarko, former CFO of Intelledge. Mr. Schwarko had administrative responsibility for patent matters at Intelledge and had been the point person for contact with the law firms handling Intelledge patent work.

29. I asked Mr. Schwarko if he or others at Intelledge had received any subsequent correspondence from Mr. England or any of the attorneys who had responsibility for the

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Intelledge patent matters. Mr. Schwarko stated that he had not received any such communications but would let me know if he or others at Intelledge did.

Recent Communications With Mr. Laff

30. On June 9, 2002, Mr. Laff granted Power to Inspect to representatives of IPMS and me to inspect and copy the file history of the '934 Application.

31. IPMS and I never received notice regarding the Notice of Defective Oath or Declaration and to the best of my knowledge, neither did Intelledge. For at least these reasons, IPMS did not intentionally abandon the above-referenced patent application.

VERIFICATION

I, Ernest J. Dale, on this 31st Day of July, 2002, hereby certify and declare under penalty of perjury pursuant to the laws of the United States of America and the Commonwealth of Virginia that the facts stated in the foregoing Declaration are true and correct to the best of my knowledge, information and belief.

